

APPLICANT(S): ANDERSON, Robert S. et al.  
SERIAL NO.: 10/767,459  
FILED: January 30, 2004  
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#### AMENDMENTS TO THE DRAWINGS

Please replace Figure 4B of record with the replacement sheet of Figure 4B, which is attached hereto. Applicants respectfully submit that the replacement sheet of Figure 4B adds no new matter.

Attachment: Replacement Sheet

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#### REMARKS

Applicants respectfully request reconsideration of the above-identified application in view of the foregoing amendments and following remarks.

#### Status of Claims

Claim 86 has been added. Claims 1-68 were previously cancelled. Accordingly, Claims 69-85 are pending in this case. Applicants respectfully assert that the amendments to the claims add no new matter.

#### Remarks to the Specification

In accordance with the observations of the Examiner on page 2 of the Office Action, the specification has been amended to correct minor grammatical errors, minor informalities, and to place the same in better form. Specifically, in paragraph 0056 "more relatively highly effective" has been replaced with "relatively more effective", in paragraph 0058, reference numerals "215" misidentifying the handpiece arms has been corrected to be "205", and in paragraph 0061, reference to Figure "2A" has been replaced with "3A". It is respectfully submitted that the amendments to the specification are editorial in nature and do not introduce new matter.

#### Remarks to the Drawings

In response to the Examiner's objection to the drawings on page 2 of the Office Action, is respectfully submitted that the drawings include every feature of the invention specified in the claims. Specifically, it is submitted that Figure 3A includes the optical energy source and their delivery means. As described in amended paragraph 0082 above, "In one embodiment, as shown in Figure 3A, the suction may pull the targeted bacteria and sebaceous gland closer to the surface so that less light from the optical source in area 250 is applied to the skin 210 required for the treatment." Hence, the optical source is located in area 250 and its delivery means is through the handpiece 200.

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### CLAIM REJECTIONS

#### 35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected Claims 68-85 under 35 U.S.C. § 112, as failing comply with the enablement requirement. It is respectfully submitted that the pending claims comply with the requirements of 35 U.S.C. § 112 and that the rejection thereunder should be withdrawn.

It is respectfully pointed out to the Examiner that Claim 68 was canceled in the previous Office Action, and thus the following remarks are directed to Claims 69, 75, and the claims dependent therefrom. A wide variety of optical energy sources are taught to be applied to the skin collected for treatment, for example, laser light, incoherent light, blue light, etc. (para.0056) As disclosed in original paragraph 0081, the suction created in the handpiece pulls the target tissue, "closer to the surface so that less light may be required for treatment". Accordingly, the upward pulling of the skin is toward the light source. As is well known to those skilled in the art, such a handpiece has an optical source therein. Thus, the added recitation to this sentence makes it now read, "In one embodiment, as shown in Figure 3A, the suction may pull the targeted bacteria and sebaceous gland closer to the surface so that less light from the optical source in area 250 is applied to the skin 210 required for the treatment." The delivery of optical energy is through the handpiece as is well known to those skilled in the art.

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims fully comply with the requirements set forth in 35 U.S.C. § 112 and that they are in condition for allowance. The rejection thereunder is respectfully requested to be withdrawn and passage to issue is therefore respectfully requested.

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### 35 U.S.C. § 102 Rejections

In the paragraphs bridging pages 3 and 4 of the Office Action, the Examiner rejected Claims 69 and 71-72 under 35 U.S.C. § 102(b), as being anticipated by Foley et al. (US Patent Appln. Publ. No. 2002/0143326) and Claims 75, 76, and 82 as being anticipated by Goldberger et al. (US Patent No. 5,772,597). It is respectfully submitted that the invention as recited in the amended claims is not anticipated by either the Foley reference or the Goldberger et al. reference and consequently the rejections thereunder should be withdrawn.

Applicants' invention as defined by the pending claims is generally directed to a device having a cavity therein. The cavity has at least two electrodes having contact surfaces adapted to contact tissue collected therebetween. The cavity further has a suction lumen in communication therewith. The device has an optical energy source adapted for transmitting optical energy to an outer surface of the tissue collected between the electrodes and an electrical energy source connected to the electrodes.

It is respectfully submitted that the Foley reference alone or in combination with any other reference does not teach or describe the invention of the pending claims. On the contrary, the reference is devoid of any teaching to have suction applied to a cavity having contact surfaces adapted to contact tissue collected therebetween. The only tissue that Foley teaches to have under suction is in interior chamber 35. This is not tissue that is between electrodes as is recited in the claim.

Thus, the Foley reference individually or collectively with any other reference does not teach or describe the invention of Applicants' pending claims. For the foregoing reasons, the pending claims are patentable over the references of record and the rejection under 35 U.S.C. § 102 should be withdrawn. Such action is respectfully requested.

It is respectfully submitted that the Goldberger et al. reference alone or in combination with any other reference does not teach or describe the invention of the pending claims. Applicants' invention recites, inter alia, "transmitting optical energy from an optical energy transmitting element to a first portion of skin tissue collected between said electrodes". On the contrary, the Goldberger reference is devoid of any teaching to treat skin tissue. The Goldberger et al. reference is directed to a laparoscopy device and method.

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Further, the optical device disclosed by Goldberger is not for skin treatment, but merely to detect the presence or absence of heart tissue within the graspers.

Accordingly, it is respectfully submitted that the Goldberger et al. reference does not anticipate Applicants' claimed invention and that the rejection under 35 U.S.C. § 102 should be withdrawn. Such action is respectfully solicited.

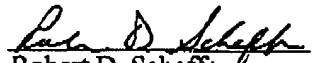
### Conclusion

In view of the foregoing, Applicants submit that the pending claims are fully supported, clearly distinguish over the prior art of record, and are in condition for allowance. Favorable consideration and passage to issue of the present application is therefore respectfully requested.

The Examiner is invited to telephone the undersigned to discuss any still outstanding matters with respect to the present application.

Please charge or credit any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

  
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